

REMARKS

In the Office Action mailed March 10, 2004, the Examiner rejected claims 1-27 and 32-35. By way of the foregoing amendments and the markings to show changes, Applicants have amended claims 10 and 16, added claims 36-38, and canceled claims 11, 15, 26. The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled in view of the prior art.

I. Claim Rejections

The Office Action of March 10, 2004 rejected claims 1-27 and 32-35 under 35 U.S.C. 103(a), "as being unpatentable over Hopton et al. (US 6253524) in view of SU 806446 (Derwent Abstract), substantially for the reasons set forth in sections 5 of Paper No. 111903..." along with additional observations. Applicants assume that Paper No. 111903 refers to the previous Office Action (i.e., the Office Action of November 28, 2003). For clarity, the following discussion will provide the dates of the respective Office Actions of the present application upon reference thereto.

Applicants traverse the rejections of claim 1-27 and 32-35 on at least two grounds. First, the combination of Hopton et al. and SU 806446 is improper. Second, the Office Action of June 24, 2003 and the Office Action of March 10, 2004 have failed to present a prima facie case of obviousness against the claims of the present application.

Improper Combination

The combination of Hopton et al. and SU 806446 is improper because, amongst other reasons¹, Hopton et al. teaches away from the claims of the present invention such that the skilled artisan would not be motivated to combine Hopton et al. and SU 806446. The Office Action of March 10, 2004, at page 3, admits that, "Hopton lacks a specific teaching that the carrier and the extension are integrally molded with the same material..." but then suggests that SU '446 teaches a process, "for forming extruded hollow profiled articles from thermoplastics having a complex configuration

¹ Applicants expressly reserve the right to argue that there is no specific reason for the combination of Hopton et al. and SU 806446 as required by the law.

with thin projecting elements as various constructions in automobiles.” The skilled artisan, however, would not have been motivated to combine Hopton et al. with SU 806446 because Hopton et al. reads, at col. 2, lines 34-38, that, “By providing the directional foaming shelf a separate element from the carrier, one carrier can be used for a variety of different applications by merely substituting different directional foaming shelves.” Thus, Hopton et al. teaches that the “foaming shelf” [which, according to the Office Action includes the at least one extension of claim 1] specifically teaches away from an “integrally molded extension” such that the skilled artisan would be very unlikely to substitute the teachings of SU 806446 into Hopton et al. Applicants respectfully request that the rejections of claims 1-27 and 32-35 of the present application based upon the combination of Hopton et al. and SU 806446 be withdrawn.

Lack of Prima Facie Case of Obviousness

Applicants traverse the rejections of several of the claims of the present application on the ground that the Office Action of March 10, 2004 has ignored or glossed over a large sum of language presented in the claims of the application to arrive at unwarranted obviousness rejections under 35 U.S.C. § 103. As such, the rejections posited by the Office Action fail to assert a prima facie case of obviousness under 35 U.S.C. § 103. As stated in the MPEP 2143.03, “To establish prima facie obviousness...all the claim limitations must be taught or suggested by the prior art.” In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, the MPEP states that, “All words in a claim must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Below, Applicants review examples of the language, which has been ignored or glossed over by the Office Action of March 10, 2004.

As an example, claim 6 of the present application reads that the, “extensions are of increased thickness relative to adjoining sections of the reinforcing member”. The Office Action of March 10, 2004, by relying on the Office Action of November 28, 2003, which relies on Page 5 of the Office Action of June 24, 2003, glosses over this language by suggesting that, “Hopton expressly teaches that the wall of the directional foaming shelf can be adjusted...” However, no specific teaching of the

“extensions” being of “increased thickness relative to adjoining sections” is ever suggested.

As another example, claim 7 of the present application reads that the reinforcing member is, “provided with small lugs, which enable the structural reinforcing member to stand away from the interior walls of the hollow structural member.” The Office Action of March 10, 2004, by relying of the Office Action of November 28, 2003, which relies on Page 5 of the Office Action of June 24, 2003, glosses over this language by suggesting that, “Hopton expressly teaches that ... the walls of the lower directional foaming shelf support the reinforcing member support the reinforcing member.” However, this suggestion is inadequate because the “walls of the lower directional foaming shelf support” would then be required to represent both the “at least one extension” and the “small lugs” of claim 7 of the present application.

As still another example, claim 18 of the present invention reads that, “the expandable material is applied over part of each of the top and bottom and the sides of the reinforcing member.” The Office Action of March 10, 2004, by relying of the Office Action of November 28, 2003, which relies on Page 6 of the Office Action of June 24, 2003, glosses over this language by suggesting that, “placing the expandable material suitably on the surfaces, including all four sides, of the reinforcing member is known art, as evidenced by the state of the art Czaplicki (US 6358584, Fig.1).” Applicants suggest that any proper rejection would actually have to apply the Czaplicki reference to claim 18 of the present invention and provide a specific motivation to combine the Czaplicki reference with Hopton et al and SU 806446.

As yet other examples, the Office Action of November 28, 2003, at page 6, glosses over language in claim 35 by suggesting that, “Claim 35 essentially contain[s] the same claimed elements of claims 1-27 and 32-33...” This rejection of claims 35 is inadequate because, amongst other reasons², it completely ignores the following language: 1) language of claim 35 reading, “a series of pairs of opposing ribs ... wherein each rib of the pairs of ribs extends transverse relative to the length

² Rejection of claim 35 is also inadequate because it treats the claims as being composed of separate elements rather than determining whether the claim, as a whole, is patentable.

of the reinforcing member”; 2) language of claim 35 reading, “wherein the unfoamed expansive adhesive material is flush with a distal end of each rib for each pair of opposing ribs prior to activation”; and 3) language of claim 35 reading, “wherein the structural reinforcing member includes a labyrinth of internal reinforcing ribs.”

In conclusion, all of the language discussed above is provided in the claims, but is not mentioned or is glossed over in the Office Action. Thus the Office Action fails to assert a prima facie case of obviousness and Applicants respectfully request that the rejections of claims 1-27 and 32-35 under 35 U.S.C. § 103 be withdrawn and that the present application be passed to issuance.

Moreover, Applicants point out that it would likely be improper to present a final rejection of claims 1-27 and 32-35 on a grounds alternative to that already presented since applicants have not amended claims 1-27 and 32-35 in a manner, which would necessitate such alternative grounds. In particular, the MPEP reads:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee...” MPEP 706.07(a)

Thus, any new grounds of rejection, “that is neither necessitated by applicant’s amendment of the claims nor base on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee...” would be improper.

II. New Claims

Applicants have added claims 36-38 to address various aspects of the present invention.

By amending the application, the Applicants do not concede that the patent coverage available to them would not extend as far as the original claim. Rather, Applicants intend to file a continuation application to pursue the breadth of the claims as filed. Applicants believe that the Examiner has not made a sufficient showing of inherency of the teachings of the asserted prior art, especially given the

lack of teachings in the cited references of the properties that Applicants have recited in their claims.

Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

CONCLUSIONS

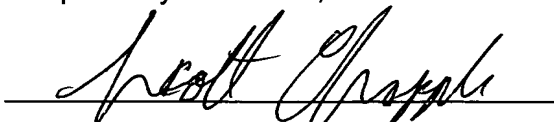
In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 593-9900.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 50-1097 for any fee which may be due.

Respectfully submitted,

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